

00766.000052

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of:

MICHIO ICHIMURA, et al.

Application No.: 09/856,617

Filed: May 24, 2001

For: NOVEL POLYPEPTIDE

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:  
) Examiner: Barbara A. Campbell  
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) Group Art Unit:  
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) Confirmation No. 3220  
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)  
:  
) November 19, 2004

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Attn: **Derek A. Putonen**  
**Attorney Advisor**  
**Office of PCT Legal Administration**

RENEWED PETITION UNDER 37 CFR § 1.137(a)

Sir:

The undersigned received a Decision dated November 8, 2004 dismissing without prejudice Applicants' August 13, 2004 Petition under 37 C.F.R. §1.137(a). The Decision notes that a proper response is made, the petition fee is satisfied and a terminal disclaimer is unnecessary. The Decision states there has been no showing the delay in filing a Petition was unavoidable.

The Decision requests evidence concerning procedures that would have avoided the error resulting in the delay, evidence concerning the training and experience of the persons responsible for the error, and copies of the applicable docketing records.

**RECEIVED**

12/03/2004 CSN001 00000001 061205 09056617  
26 NOV 2004  
Sale Ref: 00000001 DAH: 061205 09056617  
01 FC:2453  
685.00 Legal Staff  
International Division

At the outset, the application was abandoned on June 6, 2003 because

Applicant failed to properly respond to the notification of MISSING REQUIREMENTS (form PCT/DO/EO/905), mailed September 7, 2001 within the time period set therein.

But Applicants did timely respond to that notification. Indeed, as noted in previous papers, Applicants timely responded to all Patent Office actions. Nonetheless, for completeness of the file, a copy of the docketing records for this case is attached at Tab A.

Thus, in the January 30, 2004 Decision, the Patent Office states abandonment not based upon lack of timely filings, but upon lack of compliance in those filings.

In support of such, the Decision notes that the Biotechnology Systems Branch of the Scientific and Technical Information Center ("BSB-STIC") told the Office of PCT Legal Administration that

[e]ach error report, in addition to the hand notations, contains a verification summary at the back. The 'verification summary' is a printout of all errors found in a CRF by the validation program. Therefore, applicant was notified of all the errors in the verification summary.

In response, the undersigned pointed out earlier that the verification summary of printout provided with the July 2, 2002 Office Action was for an earlier CRF, not the one on file,<sup>1/</sup> and when Applicants point out those errors were already attended to, the Patent Office abandoned the application.

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<sup>1/</sup> The incorrect verification summary provided in the July 2, 2002 Notification is at Tab C of the August 13, 2004 Petition.

In any event, it is clear the CRF is now compliant; the Patent Office states the application is abandoned because the compliant CRF was not submitted quickly enough. In this regard, the BSB-STIC states "applicant was advised to run the filed CRF through the "checker" software prior to filing to identify any potential problems."

However, the BSB-STIC's comment regarding "Checker" is off-point. The Raw Sequence Error Report states that use of checker is "encouraged" to "reduce" errored sequence listings, not that such use is mandatory, nor that further errored listings are noncompliant or non-responsive.

CRF preparation is discussed in MPEP §2430 which notes "many patent applicants are accustomed to, or familiar with, the submission of such sequence information, in electronic form, to various sequence databases" and suggested use of PatentIn version 1.3 based on the GenBank input program AuthorIn. PatentIn ver. 1.3 was replaced by PatentIn versions 2.0 and 2.1, which were themselves replaced in June 2000 with PatentIn version 3.0, which was itself replaced in March 2001 with PatentIn version 3.1.

Since many patent practitioners are not accustomed to or familiar with these various programs, the MPEP further notes that "[T]he Office provides hands-on training in the use of the PatentIn and associated utilities programs."

In any event, it is unclear why this case is abandoned for a non-compliant CRF; MPEP §2429 states, explicitly,

For the most part, [the following] list is a compilation of frequently asked questions.

- Compliance is not a filing date issue.  
(Emphasis added).

In this regard, the undersigned is entirely unaware of any reason the PCT continues to refuse to grant filing dates in applications until CRFs are filed and approved. Similarly, since compliant CRFs are not, by Patent Office procedure, "mandatory" for filing dates, it is not well-understood how timely responding to each and every notification concerning the same can possibly result in abandonment, simply because new errors are identified, and especially when the Patent Office provided an incorrect verification summary, thus itself engendering the abandonment sought to be rectified.

The undersigned had not previously been trained in Checker use. Now Checker is utilized as a matter of course on all CRF's in this Office but such was not done before. Given that there was no training afforded in Checker, that use of the same was not required, that the Patent Office states their goal was to "reduce" errors (not to escape them completely), that all submissions herein were prompt, timely and in good faith, and that compliance is itself not a filing date issue, it is thought respectfully proper that this case should be returned to pending status.

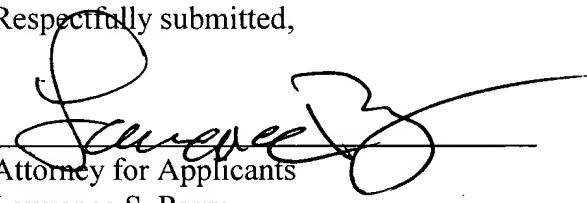
Nonetheless, if the above is not found to be sufficient explanation of an explanation of delay, then the Commissioner is hereby authorized to treat this paper as a Petition under 37 C.F.R. §1.137(b). In that event, the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. Any additional fees required in connection with such Petition may be charged to deposit account No. 06-1205.

CONCLUSION

The Assistant Commissioner is respectfully requested to restore this application to pending status and forward it for examination on the merits.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



Attorney for Applicants  
Lawrence S. Perry  
Registration No. 31,865

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-2200  
Facsimile: (212) 218-2200

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Date: 11/18/04  
Time: 14:49:08

Master List  
By Case Number

Page: 1

Case Number	Client	Atty	Assignee	Disclosure Status
766.52	NIPGI	LSP	KYOWA HAKKO KOGYO CO., LTD.	Filed

Title: NOVEL POLYPEPTIDE

Product: Client Reference: K46-130677  
Origin: JAPAN Priority Applic. #: 332484/98 File Date: 11/24/98  
Combined: 248442/99

Ctry	Sub Case No.	Type Case	Status	Appln No/ Filing Date	Patent No./ Issue Date	Agent/ Agent Ref.	Tax Schedule/ Paid Thru
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USA	ORD	PENDING	09/856617 05/24/01				NL
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Remarks: NTL PHS PCT/JP99/06487 OF 111999; FD RCD W/APPLN;COURIER  
052901-DPST DECL;FX 080802/020503/021004-SEND OFR; ERRABAND

Action Due	Due Date	Response Sent	Date Sent	Method Sent	Receipt Recvd Date
#1 STATUS CK+36	11/24/05				
#3 OFR STAT +39	12/24/04				
01 CRITIQUE DUE	04/18/01				
02 FILE APPLN	05/24/01	APPLN SENT	05/23/01	ACS/DCO	yes 05/24/01
03		PRLM/AMND+	05/23/01	ACS/DCO	yes 05/24/01
04		SONCE LIST	05/23/01	ACS/DCO	yes 05/24/01
05 RSP: ASSIGN REJ	09/09/01	RESP SENT+	09/10/01	COM	yes 09/18/01
06		FRML DWGS	09/10/01	COM	yes 09/18/01
07 RESP:SEQUENCE	11/07/01	RESP	09/24/01	ACS/DCO	yes 09/25/01
08 NOTE:DEFECT RSP	07/02/02				
09 RSP: SEQUENCE +	08/02/02	SEQ LIST+	08/02/02	COM	yes 08/05/02
10 CLAIM FEES	08/02/02	DPST ACCT	08/02/02	COM	yes 08/05/02
11 RCRD ASSIGN	07/25/02				
12		RQ FI RCPT	10/24/02	ACS/DCO	yes 10/25/02
13 FEES DUE +	02/09/03	RESP W/FEE	01/21/03	ACS/DCO	yes 01/22/03
14 RESP: SEQUENCE	02/09/03	CORR CRF	01/21/03	ACS/DCO	yes 01/22/03
15		CO FI RCPT	03/12/03	ACS/DCO	yes 03/13/03
16 ERR/ABANDONMENT	06/06/03				
17 ST: WTHD ABAND	07/06/03	WTHD ABAND	06/19/03	ACS/DCO	yes 06/20/03
18 WTHD ABAND ST+3	03/20/04				
19		REQ DECISN	01/07/04	ACS/DCO	yes 01/08/04
20 PET DISMISSED	01/21/04				
21		RQ RCONSDR	02/04/04	ACS/DCO	yes 02/05/04
22 PET DISMISSED	05/17/04				
23		PET REVIVE	08/12/04	ACS/DCO	yes 08/13/04
24 PET DISMISSED	11/08/04				

Date: 11/18/04  
Time: 14:49:08

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By Case Number

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25 REQ RECONSIDER 01/08/05

Inventor(s)

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ICHIMURA, M  
HIROSE, R  
YOSHIOKA, K  
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